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TRANSMITTAL FORM

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Application Number	09/583,087
Filing Date	September 5, 2000
First Named Inventor	Shunpei YAMAZAKI
Group Art Unit	2815
Examiner Name	J. Jackson, Jr.
Attorney Docket Number	0756-2203

ENCLOSURES *(check all that apply)*

- ☐ Fee Transmittal Form
- ☒ Fee Attached
- ☒ Amendment / Reply
- ☐ After Final
- ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☒ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
- ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Assignment Papers *(for an Application)*
- ☐ Drawing(s)
- ☐ Declaration and Power of Attorney
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
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- ☐ CD, Number of CD(s) _____
- ☐ After Allowance Communication to Group
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to Group *(Appeal Notice, Brief, Reply Brief)*
- ☐ Proprietary Information
- ☐ Status Letter
- ☐ Other Enclosures
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Remarks

☒ The Commissioner is hereby authorized to charge any additional fees required or credit any overpayments to Deposit Account No. 50-2280 for the above identified docket number.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Eric J. Robinson, Reg. No. 38,285 Robinson Intellectual Property Law Office, P.C. PMB 955 21010 Southbank Street Potomac Falls, VA 20165
Signature	
Date	12-20-02

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Docket No. 0756-2203

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of	)	Art Unit: 2815
Shunpei YAMAZAKI	)	Examiner: J. Jackson, Jr.
Serial No. 09/583,087	)	
Filed: September 5, 2000	)	
For: ELECTRO-OPTICAL DEVICE AND METHOD FOR MANUFACTURING THE SAME	)	

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#27 Response 08/583,087 1-1603

RESPONSE

Honorable Commissioner of Patents
Washington, D.C. 20231

Sir:

The Official Action mailed August 23, 2002 has been received and its contents carefully noted. Filed concurrently herewith is a *Request for One Month Extension of Time*, which extends the shortened statutory period for response to December 23, 2002. Accordingly, Applicant respectfully submits that this response is being timely filed.

Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on September 5, 2000; February 15, 2001; March 15, 2001; August 15, 2001, November 2, 2001; and June 21, 2002. However, Applicants have not received acknowledgement of the Information Disclosure Statement filed on March 22, 2001. Applicant respectfully requests the Examiner to provide an initialed copy of the Form PTO-1449 evidencing consideration of this Information Disclosure Statement. A further Information Disclosure Statement is submitted herewith and careful review and consideration of this Information Disclosure Statement is requested.

Claims 21-41 and 43-60 are pending in the present application, of which claims 21-32 and 41 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance.

The Official Action rejects claims 21-41 and 43-90 under the doctrine of obviousness-type double patenting based on the combination of claims 1-46 of U.S. Patent 6,023,075, JP 2-234134 to Sumiyoshi, the article *An Active-Matrix LCD with*

Integrated Driver Circuits Using a-Si TFTs by Akiyama, and U.S. Patent 5,656,826 to Misawa. It is noted that the Official Action refers to "Sumiyoshi '075" but it is understood that the rejection is based on Sumiyoshi '134. Clarification is requested if this understanding is incorrect. Applicant respectfully requests that this rejection be held in abeyance until an indication of allowability has been received, at which time a complete response will be made to any remaining double patenting objections.

The Official Action next rejects claims 21-41, and 43-90 as obvious based on the combination of U.S. Patent 3,821,781 to Chang, U.S. Patent 5,656,826 to Misawa, JP 60-245173 to Yamazaki, U.S. Patent 4,703,552 to Baldi, JP 2-234134 to Sumiyoshi and the article *An Active-Matrix LCD with Integrated Driver Circuits Using a-Si TFTs* by Akiyama.

As stated in MPEP § 2143-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab,* 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Official Action appears to contend that it would have been obvious to combine the teachings of Sumiyoshi with Misawa and Akiyama. That is, Misawa and Akiyama allegedly teach peripheral and pixel transistors of high mobility and similar structure. Sumiyoshi allegedly teaches a leveling film over the pixel transistor.

Therefore, the Official Action apparently asserts that it would have been obvious to use the leveling film of Sumiyoshi over the pixel transistor and the peripheral transistor of Misawa and Akiyama.

Applicant respectfully disagrees. It is respectfully submitted that the Official Action has failed to show sufficient motivation to combine the references to achieve the present invention. In response to Applicants earlier arguments, the Official Action merely states that "together the references suggest applicant's claimed invention" but fails to provide a sufficient basis that one of skill in the art would have been motivated to make this combination. It is submitted that the burden of showing sufficient motivation to combine references lies with the Office. MPEP § 2142 states "The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. If, however, the examiner does produce a *prima facie* case, the burden of coming forward with evidence or arguments shifts to the applicant who may submit additional evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art. The initial evaluation of *prima facie* obviousness thus relieves both the examiner and applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention."

It is respectfully submitted that the Official Action has failed to carry this burden. It is submitted that the Official Action does not adequately set forth why one of skill in the art would combine the references to achieve the present invention. MPEP § 2142 further states: "The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. 'To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.' *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)."

Favorable reconsideration of the outstanding rejections is respectfully requested in view of the above. Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,

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